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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,555	03/04/2005	Masaki Aoki	43890-719	7423
20277 7590 07/09/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER KOSLOW, CAROL M				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary

Application No.

10/526,555

Applicant(s)

AOKI ET AL.

Examiner

C. Melissa Koslow

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-10 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 5, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

This action is in response to applicants' amendment of 28 April 2008. The amendments to the claims have overcome the 35 USC 112 rejections and the objections to the claims.

Applicant's arguments with respect to U.S. patent 5,289,081 and JP 2000-285809 have been fully considered and are persuasive. The rejection based on these references has been withdrawn. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

The amendment to the claims filed on 28 April 2008 does not comply with the requirements of 37 CFR 1.121(c) because the corrections to the formulas are not marked. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being

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amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10, 13 and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-9 of U.S. Patent No. 7,288,889. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the patented process produces the phosphor claimed in this application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 7-9 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by the translation for JP 11-86735.

This reference teaches $\text{Zn}_2\text{SiO}_4:\text{Mn}^{2+}$ phosphor particles coated with MgO , ZnO or Al_2O_3 and plasma display units, which have the claimed structure, containing these particles. Since the coated particles are same as that claimed, the taught particles must have a degree of charge suppression in the claimed range, absent any showing to the contrary. The reference teaches the claimed unit and phosphor.

Claims 10, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 5,744,233 or 5,985,175.

These references teach $\text{Y}_2\text{O}_3:\text{Eu}^{+3}$ phosphors coated with B_2O_3 , or a mixture of silica and TiO_2 or B_2O_3 . Since the coated particles are same as that claimed, the taught particles must have a degree of charge suppression in the claimed range, absent any showing to the contrary. The references teach the claimed phosphor.

Claims 7-9 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by the WO 03/056596.

U.S. patent 7,232,530 is the national stage application for WO 03/056596 and thus it is the translation for WO 03/056596.

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This reference teaches $\text{Zn}_2\text{SiO}_4\text{:Mn}^{2+}$ phosphor particles coated with MgO , ZnO or Al_2O_3 . These particles are used in plasma display units, which have the claimed structure. Since the taught particles are same as that claimed, the taught particles must have a degree of charge suppression in the claimed range, absent any showing to the contrary. The reference teaches the claimed unit and phosphor.

Claims 1, 4, 6, 10, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 03/025090 or WO 03/025088.

Claims 1, 4, 6, 10, 13 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. patent application publication 2004/0051440 or 2004/0043692.

U.S. patent application publication 2004/0051440 is the national stage application for WO 03/025090 and thus is the translation for WO 03/025090.

U.S. patent application publication 2004/0043692 is the national stage application for WO 03/025088 and thus is the translation for WO 03/025088.

These references teach $\text{MMgAl}_{10}\text{O}_{17}\text{:xEu}^{2+}$, where M is Ba_{1-x} or $\text{Ba}_{1-x-y}\text{Sr}_y$, x is 0.03-0.2 and y is 0.1-0.5 coated with SiO_2 . These particles are used in plasma display units, which have the claimed structure. Since the taught particles are same as that claimed, the taught particles must have a degree of charge suppression in the claimed range, absent any showing to the contrary. The reference teaches the claimed unit and phosphor.

Applicants' arguments with respect to all the above rejections is that there is no teaching that the taught compositions have an absolute charge of the phosphor that does not exceed 0.01 $\mu\text{C/g}$. As discussed above, the taught particles are identical to those claimed and thus one of ordinary skill in the art would expect the taught particles to inherently have this property.

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Applicants have not presented any evidence that the taught particles do not have a charge in the claimed range. The fact Optiz, Fan, Sugimoto and Kawamura '889 coat the particles for a different reason than applicants do not overcome the rejections since the resulting particles are identical to those claimed and thus would be expected to have the claimed property. The fact that Kurai and Kawamura' 596 teaches the coating changes the charge to positive or a zero to positive does not overcome the rejection since the claims allow for the particles to have a zero to positive charge up to 0.01 $\mu\text{C/g}$ and there is no showing that the taught particles have a positive charge outside the claimed range. The rejections are maintained.

Claims 2, 3, 5, 11 and 12 would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The device of claim 5 is not taught or suggested by the cited art of record. Claims 2, 3, 11 and 12 would be allowable for the reasons given in the previous action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/cmk/
July 8, 2008

/C. Melissa Koslow/
Primary Examiner
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